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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SALVATORE REA, MALCOLM WADDOUPS, ROLFE J.
HARTLEY, RICARDO A. BLOCH, MICHAEL D. HOEY, and GEORGE
C. L'HEUREUX

Appeal 2009-015251
Application 10/657,687
Technology Center 1700

Before EDWARD C. KIMLIN, CATHERINE Q. TIMM, and LINDA M.
GAUDETTE, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to reject claims 1-19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellants' invention relates to a lubricating oil composition including a mixture of first and second rust inhibitors. Claim 1 is illustrative:

1. A lubricating oil composition suitable for use in a four stroke marine engine which comprises an oil of lubricating viscosity containing an admixture of

- (a) 1 - 3.75 wt.% of an ashless dispersant;
- (b) a metal detergent;
- (c) an oil soluble molybdenum compound in an amount sufficient to provide 15 - 1,000 ppm molybdenum in the composition;
- (d) a zinc dialkyl dithiophosphate in an amount sufficient to provide at least 1,200 ppm phosphorus in the composition;
- (e) *a rust inhibitor system comprising*
 - (i) *as a first rust inhibitor*, an ethoxylated C₄-C₁₈ alkyl phenol having 2-10 moles of ethylene oxide per mole
in combination with a second rust inhibitor selected from the group consisting of
 - (ii) a glycerol ester of a C₈-C₂₂ fatty acid,
 - (iii) a half ester of a C₈-C₂₂ alkyl or alkenyl succinic acid and a C₂-C₄ alkylene glycol and
 - (iv) a C₈-C₂₂ alkyl or alkenyl succinic acid or anhydride; and
 - (f) optionally, a viscosity modifier, said composition having a NOACK volatility less than 15%.

(Claim 1, emphasis and indenting added.)

The Examiner maintains, and Appellants seek review of, the following rejections:

(1) The rejection of claims 1-19 under 35 U.S.C. § 103(a) as unpatentable over US Patent No. 6,207,625 B1 ("Ogano") in view of US Patent No. 3,893,168 ("Brehm") or US Patent No. 2,833,717 ("Whitacre"); and

(2) The rejection of claims 1-9 and 11-19 under 35 U.S.C. § 103(a) over US Patent No. 6,444,624 B1 ("Walker") in view of US Patent No. 3,876,550 ("Holubec") and further in view of US Patent No. 3,893,168 ("Brehm") or US Patent No. 2,833,717 ("Whitacre").²

II. DISCUSSION

To support each rejection, the Examiner cites evidence that rust inhibitors of the first group and the second group claimed were known in the art for use in lubricating oils (Ans. 3-6). The Examiner concludes based on this evidence that "given that the prior art references teach the presently claimed rust inhibitors, it would have been obvious to one of ordinary skill in the art [to] utilize a combination of two or more, absent a showing of unexpected or surprising results with respect to the combination." (Ans. 7.)

There is really no question that the Examiner has established a prima facie case of obviousness. Appellants do not dispute that the rust inhibitors were known in the art, and, as stated in *In re Kerkhoven*, "[i]t is prima facie

² The Examiner withdrew a rejection based on obviousness double patenting in light of the terminal disclaimer filed by Appellants with the Brief (Comm. of Jun. 17, 2009).

obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose.” *In re Kerkhoven*, 626 F.2d 846, 850 (CCPA 1980). Moreover, we agree with the Examiner that this is the type of situation calling for a showing of unexpected results arising from the combination to support patentability.

Appellants’ sole contention on appeal is that “[t]he Examiner seems to dismiss the fact that the claimed invention claims a specific and novel rust inhibitor system in combination with the other recited components [sic, which] enables the claimed combination to exhibit superior rust performance,” and, as evidence of this “superior rust performance,” Appellants rely upon evidence submitted in an affidavit attached to the Brief (Br. 4). However, because the Examiner determined that the affidavit did not meet the requirements of 37 C.F.R. § 41.33, the Examiner did not enter it (Ans. 7).

The affidavit is not before us on appeal and, therefore, we cannot consider the evidence it contains. Therefore, we cannot say that the Appellants have provided the necessary evidence on this record to overcome the prima facie case of the Examiner.

III. CONCLUSION

On the record before us, we sustain the rejections maintained by the Examiner.

IV. DECISION

The decision of the Examiner is affirmed.

V. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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